

IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

GAME SHOW NETWORK, LLC and)
WORLDWINNER.COM, INC.,)
) Petitioners,) Case No.
vs.) IPR2013-00289
JOHN H. STEPHENSON,)
) Patent Owner.)

DEPOSITION OF
E. JAMES WHITEHEAD, PH.D.

January 10, 2014
The Hilton Santa Cruz, 6001 La Madrona Drive
Santa Cruz, California

REPORTED BY:
KATHERINE E. LAUSTER CSR 1894, RPR, CRR, LCR

DIGITAL EVIDENCE GROUP
1726 M Street NW, Suite 1010
Washington, DC 20036
(202) 232-0646

1 A P P E A R A N C E S
2
3 FOR PETITIONERS GAME SHOW NETWORK and
WORLDWINNER.COM:
4 THOMAS LEACH, ESQ.
tleach@merchantgould.com
5 MERCHANT & GOULD
6 3200 IDS Center
7 80 South 8th Street
Minneapolis, Minnesota 55402-2215
8 t.612.336.4665 f.612.332.9081
9
10 FOR THE PATENT OWNER JOHN H. STEPHENSON:
11 TED M. CANNON, ESQ.
ted.cannon@knobbe.com
12 KNOBBE, MARTENS, Olson & Bear, LLP
13 2040 Main Street, 14th Floor
Irvine, California 92614
14 t.949.760.0404 f.949.760.9502
15 and
16 MILES A. ZVI, ESQ.
mzvi@gsn.com
17 GAME SHOW NETWORK
18 2150 Colorado Avenue, Suite 100
Santa Monica, California 90404
19 t.310.255.6901 f.310.255.6989
20
21
22

Page 2

1 STEPHENSON DEPOSITION EXHIBITS:
2 NUMBER DESCRIPTION PAGE
3 Exhibit 2002 U.S. Patent No. 6,174,237 B1;
4 1-16-01; 7 pages.....117
5
6 Exhibit 2003 Decision: 11-19-13; 22 pages.....209
7
8 Exhibit 2004 Computer printout "Rules of
9 Card Games: Double Solitaire":
Printed 1-6-14, http://web.
10 archive.org/web/19991003061805/
11 http://www.pagat.com/patience/
12 double.html[01/06/2014 3:17:31
13 PM]; 1 page.....112
14
15 Exhibit 2005 Computer printout "Double
16 Solitaire": Interactive Solitaire
Network Card Game": Printed
17 1-6-14, http://web.archive.org/
/web/19990302020628/http://
18 solitaire.com[01/06/2014 3:20:05
19 PM]; 2 pages.....112
20
21 ---o0o---
22

Page 4

1 INDEX OF EXAMINATIONS
2 WITNESS: E. JAMES WHITEHEAD, PH.D.
3 ATTORNEY PAGE
4 BY MR. LEACH 5, 149, 242
5 BY MR. CANNON 225
6
7
8 EXHIBIT INDEX
9 GAMESHOW NETWORK DEPOSITION EXHIBITS:
10 NUMBER DESCRIPTION PAGE
11 Exhibit 1002 International Patent Application
12 Publication No. WO 97/39811:
13 10-30-97; 53 pages.....150
14
15 Exhibit 1005 Declaration of E. James
16 Whitehead, Jr., Ph.D. In Support
of Petition for Inter Partes
17 Review of U.S. Patent No.
18 6,174,237; 5-17-13; 76 pages.....81
19
20 Exhibit 1006 Curriculum Vitae: 5-17-2013;
21 8 pages.....10
22

Page 3

1 SANTA CRUZ, CALIFORNIA
2 FRIDAY, JANUARY 10, 2014; 9:12 A.M.
3 ---o0o---
4 THE REPORTER: Before we begin, I need to
5 put you under oath.
09:02:01 6 THE WITNESS: Okay.
7 THE REPORTER: Do you solemnly state,
09:02:09 8 under penalty of perjury, the testimony you are
9 about to give will be the truth, the whole truth,
10 and nothing but the truth?
09:02:03 11 THE WITNESS: I do.
12
13 E. JAMES WHITEHEAD, Ph.D.,
14 having been duly sworn,
15 testified on his oath as follows:
16
17 EXAMINATION
09:02:03 18 BY MR. LEACH:
09:02:04 19 Q. Okay. Good morning, Dr. Whitehead.
09:02:07 20 A. Good morning.
09:02:09 21 Q. Can you please state your full name for
09:02:09 22 the record?

Page 5

09:02:09 1 A. Sure. Emmet James Whitehead, Jr.
 09:02:09 2 THE REPORTER: Hang on for a second.
 09:02:09 3 THE WITNESS: Okay.
 09:02:09 4 THE REPORTER: I have a problem.
 09:02:09 5 Okay.
 09:02:18 6 BY MR. LEACH:
 09:02:18 7 Q. And can you spell that too, please?
 09:02:20 8 A. Sure. Emmet, E-m-m-e-t, James, J-a-m-e-s,
 09:02:27 9 Whitehead, W-h-i-t-e-h-e-a-d, Junior.
 09:02:36 10 MR. LEACH: And can we put on the record
 09:02:37 11 here who is representing here?
 09:02:39 12 MR. CANNON: Sure.
 09:02:39 13 MR. LEACH: Okay. I'm Tom Leach with
 09:02:42 14 Merchant & Gould, and I represent the patent owner,
 09:02:45 15 John Stephenson.
 09:02:47 16 MR. CANNON: I'm Ted Cannon with Knobbe,
 09:02:50 17 Martens, Olson & Bear. I represent the petitioners,
 09:02:52 18 Game Show Network and WorldWinner.
 09:02:56 19 And with me attending is Miles Zvi,
 09:02:58 20 in-house counsel of Game Show Network.
 09:03:03 21 BY MR. LEACH:
 09:03:05 22 Q. Have you ever deposed before

Page 6

09:04:12 1 Q. And how long was the meeting yesterday?
 09:04:13 2 A. The meeting lasted approximately
 09:04:15 3 seven-and-a-half hours.
 09:04:20 4 Q. And can you tell me generally what you
 09:04:22 5 guys discussed in that meeting?
 09:04:24 6 A. We went over all of the claims in the
 09:04:30 7 Stephenson patent. We went over all of the points
 09:04:37 8 in my declaration concerning the -- the Stephenson
 09:04:42 9 patent. You know, we talked about Walker and what
 09:04:45 10 Walker had to say with respect to those.
 09:04:50 11 There was some discussion of how this
 09:04:52 12 particular proceeding would take place.
 09:04:54 13 Q. Okay. Did you look at any documents other
 09:04:58 14 than the Stephenson patent, the '237 patent, Walker,
 09:05:04 15 and your declaration?
 09:05:06 16 A. I did look at the Board preliminary ruling
 09:05:14 17 in the inter partes, and -- let's see. Also looked
 09:05:18 18 at the response that you prepared to that. So those
 09:05:24 19 were the -- I did not look at any other documents in
 09:05:27 20 preparation.
 09:05:27 21 Q. Thank you.
 09:05:32 22 Can you tell me generally what you know

Page 8

09:03:07 1 Mr. Whitehead -- or Dr. Whitehead?
 09:03:08 2 A. No.
 09:03:09 3 Q. Are you on any medication today that would
 09:03:12 4 impede your ability to understand my questions and
 09:03:14 5 answer -- answer truthfully?
 09:03:16 6 A. No.
 09:03:18 7 Q. If you don't understand a question that I
 09:03:19 8 ask, please let me know and I can clarify.
 09:03:24 9 Otherwise, if you answer, I assume that you
 09:03:27 10 understood the question and that the answer you gave
 09:03:29 11 is -- is your answer.
 09:03:31 12 A. Okay.
 09:03:34 13 Q. How did you prepare for your deposition
 09:03:36 14 today?
 09:03:37 15 A. Sure. So in preparation for the
 09:03:42 16 deposition today, read through the Stephenson
 09:03:48 17 patent, read through the Walker patent, read through
 09:03:54 18 my declaration.
 09:03:56 19 We also had a -- a meeting yesterday to --
 09:04:00 20 with Ted Cannon and Miles Zvi, to go over the, you
 09:04:07 21 know, materials in the two patents and in my
 09:04:10 22 declaration as well.

Page 7

09:05:34 1 about patent law?
 09:05:36 2 A. So I'm not a lawyer and I'm not trained in
 09:05:39 3 patent law. I have been involved as an expert
 09:05:45 4 witness on several prior patent cases, so I have,
 09:05:49 5 you know, picked up some knowledge of patent law
 09:05:53 6 through that, but I don't claim any particular
 09:05:57 7 expertise in patent law.
 09:05:59 8 Q. Do you have a -- any patents of your own?
 09:06:01 9 A. I do not, no.
 09:06:07 10 Q. Can you tell me what cases that you've
 09:06:08 11 worked on as an expert in terms of patent law or
 09:06:13 12 patent cases?
 09:06:15 13 A. I guess, you know, I -- would be hard for
 09:06:18 14 me, on the spur of the moment here, to give you the
 09:06:20 15 exact, you know, names of the cases, so --
 09:06:23 16 Q. About how many were there?
 09:06:28 17 A. I believe it has been five -- five or six.
 09:06:34 18 Q. And in those five or six cases have you
 09:06:37 19 ever been deposed?
 09:06:38 20 A. No.
 09:06:39 21 Q. And I assume you've never been -- or
 09:06:42 22 you've never testified then, in those cases?

Page 9

09:06:44 1 A. No, I have made declarations, but I've
 09:06:48 2 never, you know, formally testified.
 09:07:00 3 Q. How did you come to understand the legal
 09:07:03 4 principles that you applied in your expert report?
 09:07:05 5 A. Right. So I had the legal principles
 09:07:08 6 explained to me by Ted Cannon and, you know, I used
 09:07:10 7 that in -- you know, that explanation -- in
 09:07:13 8 formulating my opinion on the case.
 09:07:19 9 Q. I'm going to hand you what's been marked
 09:07:21 10 as Game Show Network Exhibit 1006.
 09:07:29 11 (Game Show Network Exhibit Number 1006 was
 09:07:29 12 presented to the witness.)
 09:07:36 13 BY MR. LEACH:
 09:07:36 14 Q. Can you review this document and tell me
 09:07:39 15 what it is?
 09:07:40 16 A. This is my curriculum vitae.
 09:07:46 17 Q. And this was attached to your declaration,
 09:07:48 18 which was Game Show Network Exhibit 1005; correct?
 09:07:54 19 A. That is correct, yes.
 09:07:59 20 Q. In terms of your education, is everything
 09:08:03 21 on your curriculum vitae or Exhibit 1006?
 09:08:09 22 A. Yes. Yes, it is.

Page 10

09:08:11 1 Q. Do you have anything you'd like to add to
 09:08:13 2 it, such as certifications or other publications?
 09:08:17 3 A. No, this is correct.
 09:08:19 4 Q. In terms of your work history, does your
 09:08:24 5 CV accurately reflect your work history as well?
 09:08:27 6 A. Yes, it does.
 09:08:28 7 Q. Is there anything you'd like to add?
 09:08:30 8 A. No.
 09:08:31 9 Q. In terms of your work history and your
 09:08:33 10 education, do you think there's anything that's not
 09:08:36 11 on your Curriculum Vitae that it -- would be
 09:08:38 12 relevant and pertinent to this matter?
 09:08:42 13 A. There are a few things, yes. So one, you
 09:08:47 14 know, in the context of creating the game design
 09:08:53 15 program at the University of California, Santa Cruz,
 09:08:57 16 I was involved in creating our library's collection
 09:09:01 17 of computer games. And so this involved a
 09:09:04 18 substantial amount of background research in
 09:09:07 19 computer games from the, you know, '80s, '90s, and
 09:09:12 20 2000s, to try and to understand which games would be
 09:09:15 21 the best ones to include in our collection.
 09:09:18 22 So I think that kind of background

Page 11

09:09:20 1 knowledge about computer games in the, you know,
 09:09:24 2 pre-2000 period is not, I think, as accurately
 09:09:28 3 reflected on the CV as my knowledge is.
 09:09:31 4 Q. Okay. And when did you review that
 09:09:33 5 material or -- or put together this library of
 09:09:35 6 computer games?
 09:09:37 7 A. That occurred in the period of 2007 to
 09:09:42 8 2010, primarily.
 09:09:50 9 Q. Can you generally tell me the process of
 09:09:54 10 preparing your declaration?
 09:09:56 11 A. Sure. So the process of preparing the
 09:10:00 12 declaration, you know, was contacted by Ted Cannon
 09:10:06 13 to perform an analysis of the Stephenson patent.
 09:10:10 14 That -- was asked to perform that analysis with
 09:10:15 15 respect to the Walker patent.
 09:10:19 16 I was -- had explained to me the legal
 09:10:22 17 principles by which to perform my analysis, so I
 09:10:27 18 then read the Walker patent and the Stephenson
 09:10:30 19 patent, and then prepared my analysis based on that.
 09:10:36 20 Ted Cannon and I had some phone
 09:10:37 21 conversations to go over that analysis. The -- you
 09:10:41 22 know, the declaration was prepared. You know, there

Page 12

09:10:47 1 were a few revisions of that, and then the final
 09:10:50 2 draft was -- was developed, and that's what you see
 09:10:53 3 before you.
 09:10:54 4 Q. Who wrote the first draft of the
 09:10:57 5 declaration? I mean physically wrote it.
 09:11:00 6 A. Right. The first draft was created
 09:11:03 7 primarily by Ted Cannon, but there was some
 09:11:07 8 contribution from myself in that draft as well.
 09:11:10 9 Q. Okay. Can you tell me what your
 09:11:12 10 contribution was?
 09:11:12 11 A. At this point, I know it's long enough ago
 09:11:16 12 I don't recall exactly which -- which sections were
 09:11:21 13 my direct contribution and which ones were his.
 09:11:24 14 Q. So would it be fair to say that Ted
 09:11:27 15 drafted portions of it that came directly from him,
 09:11:29 16 and other portions came directly from you, and he
 09:11:32 17 put those together in one declaration?
 09:11:34 18 A. Yes.
 09:11:35 19 Q. And can you tell me about what portions
 09:11:41 20 came from Mr. Cannon and what portions came from
 09:11:46 21 you?
 09:11:48 22 A. You know, again, it was, you know, at this

Page 13

09:11:49 1 point, many months ago. You know, I just don't
 09:11:52 2 recall at that level of specificity anymore.

09:11:58 3 Q. Going back to the library of computer
 09:12:01 4 games that you put together in 2007 to 2010, can you
 09:12:07 5 tell me how you went about doing that, and -- and
 09:12:10 6 first start with how many people were involved in
 09:12:12 7 the process? Were you supervising it or were you
 09:12:15 8 doing the research, pulling information and reading
 09:12:19 9 it to decide what went into the library, such
 09:12:24 10 things?

09:12:25 11 A. Right. Yeah, the process for that
 09:12:27 12 involved me working with a small group of
 09:12:31 13 undergraduate students who had the knowledge about
 09:12:35 14 computer games, and they helped identify candidate
 09:12:39 15 games, but the -- sort of the actual purchase
 09:12:44 16 decisions, you know, those all came from myself.

09:12:48 17 So I primarily was, you know,
 09:12:51 18 investigating a large number of games, primarily by
 09:12:55 19 looking up entries in Wikipedia, but also on other
 09:13:00 20 websites, to try and assess the importance and the
 09:13:06 21 contribution of the game. And then, you know, based
 09:13:08 22 on that importance and its contribution in the

Page 14

09:13:11 1 evolution of game design, I decided whether that
 09:13:14 2 game should be purchased or not.

09:13:15 3 Q. Okay. When you say a "library of games"
 09:13:18 4 is this physical -- like Nintendo, the box and some
 09:13:21 5 of the games that went with it, or -- tell me what
 09:13:24 6 is included in this library. I was thinking more a
 09:13:27 7 traditional library containing books, but --

09:13:31 8 A. Right. Sure. Yeah, it's a -- the library
 09:13:35 9 itself contains a number of kind of examples of the
 09:13:38 10 game media, whether that's a particular cartridge,
 09:13:40 11 or a floppy disk, or a CD ROM.

09:13:46 12 And the -- the library collection also
 09:13:49 13 does include some of the game consoles in cases
 09:13:53 14 where those are -- are harder to get, and the
 09:13:57 15 physical storage is sort of in a series of cabinets,
 09:14:00 16 but, you know, they're all cataloged, and they're
 09:14:03 17 available to be found, and checked out, and taken
 09:14:06 18 out and played, and then -- then returned.

09:14:09 19 Q. About how many different games do you
 09:14:11 20 have?

09:14:12 21 Or let's start with this. How many
 09:14:14 22 different game consoles or -- or -- I guess what

Page 15

09:14:19 1 would you call it? How many different formats or
 09:14:23 2 consoles do you have?

09:14:24 3 A. Right. Game consoles in the collection,
 09:14:28 4 as I recall, it's about six or seven.

09:14:31 5 Q. Okay. And then how many different
 09:14:34 6 games -- are you saying that maybe one console might
 09:14:37 7 have multiple games?

09:14:40 8 A. Right. Sure, yeah. So there are a little
 09:14:43 9 over 700 distinct titles, although some of those
 09:14:46 10 titles contain collections of games. So the total
 09:14:49 11 number of games is, I'm guessing, somewhere in the
 09:14:53 12 range of 850 to 900 distinct games.

09:14:57 13 Q. When you were approached by Mr. Cannon to
 09:15:02 14 help on this matter, did you discuss this game
 09:15:07 15 library?

09:15:10 16 A. I don't recall having discussed the game
 09:15:13 17 library particularly, you know, as part of my
 09:15:19 18 overall qualifications, though there was a
 09:15:21 19 discussion, when he first called, you know, about my
 09:15:25 20 qualifications. And, you know, that experience
 09:15:28 21 along with, you know, many other aspects of my
 09:15:32 22 background made me feel that I had the

Page 16

09:15:34 1 qualifications to serve as an expert in this case.

09:15:38 2 Q. At some point did you disclose to
 09:15:40 3 Mr. Cannon, obviously, that you had this game
 09:15:43 4 library and you helped put it together?

09:15:45 5 A. I cannot recall whether I did or not.

09:15:49 6 Q. When did it -- when did you first tell
 09:15:52 7 Mr. Cannon or anyone at his law firm or GSN and
 09:16:00 8 WorldWinner, for that matter, about the game
 09:16:02 9 library?

09:16:03 10 A. Again, I -- I do not recall.

09:16:05 11 Q. Was it before today?

09:16:11 12 A. It would have been in the initial
 09:16:13 13 discussion of my credentials.

09:16:14 14 Q. And when would that have taken place?

09:16:16 15 A. That would have been back in, I believe,
 09:16:19 16 April of 2013.

09:16:22 17 Q. Going back to this game library, you said
 09:16:25 18 you had a small group of people that were
 09:16:27 19 identifying games. How did they go about
 09:16:30 20 identifying games?

09:16:31 21 A. That was based on their background
 09:16:35 22 expertise from having played these games or having a

Page 17

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.